

## REMARKS

Claims 1, 7, 11, 36, 45-46, 53, 62-63, 70, and 79-80 were pending prior to this response. By the present communication, claims 1, 70 and 79 have been amended to define Applicants' invention with greater particularity. In particular, claim 70 has been amended by underlining the word "and", which was not properly designated as being added to the claim in the Response to Notice of Noncompliant Amended filed herein on August 7, 2006. The amendment to claim 79 is made to conform the designation of HIF-1 and EPAS-1 to that of the other claims. The amendments add no new matter, being fully supported by the Specification and originally filed claims. Accordingly, claims 1, 7, 11, 36, 45-46, 53, 62-63, 70, and 79-80 are currently pending.

### **The Restriction Requirement**

Claims 1, 11, 36, 45-46, 53, 62-63, 70, and 79-80 read on the elected species. If a generic claim is held to be allowable, Applicants request prosecution of all presently pending claims.

### **The Non-statutory Double Patenting Rejections**

A. Applicants respectfully traverse the provisional rejection of claims 1, 7, 11, 36, 45, 46, 53, 62, 63, 70 and 80, for allegedly being unpatentable over claims 19, 24, 25, 29-32, 34 and 47-49 of co-pending U.S. Application No. 10/618,183. A provisional rejection for non-statutory Double Patenting can be overcome by Applicants filing a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(c) or § 1.321(d) provided the conflicting application is commonly owned with this application. According, Applicants herewith submit a Terminal Disclaimer showing that the present application and co-pending application 10/618,183 are currently co-owned.

In view of the Terminal Disclaimer filed herein, Applicants respectfully submit that the provisional rejection of claims 1, 7, 11, 36, 45, 46, 53, 62, 63, 70 and 80 for allegedly being unpatentable under the judicially established doctrine of non-statutory unobviousness is overcome. Accordingly, withdrawal of the rejection is respectfully requested.

**B.** Applicants respectfully traverse the rejection of claims 36, 53 and 70, for allegedly being unpatentable over claims 1-5 and 18 of U.S. Patent No. 7,097,832. A rejection for non-statutory Double Patenting can be overcome by Applicants filing a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(c) or § 1.321(d) provided the conflicting application is commonly owned with this application. According, Applicants herewith submit a Terminal Disclaimer showing that the present application and U.S. Patent 7,097,832 are currently co-owned.

In view of the Terminal Disclaimer filed herein, Applicants respectfully submit that the rejection of claims 36, 53 and 70 for allegedly being unpatentable under the judicially established doctrine of non-statutory unobviousness is overcome. Accordingly, withdrawal of the rejection is respectfully requested.

In view of the above amendments and remarks, Applicants submit that all objections and rejections are now overcome, and passage of the claims to allowance is respectfully requested.

#### **The Defective Declaration**

The Examiner asserts that a new oath or declaration in compliance with 37 C.F.R. 1.67(a) identifying this application by application number and filing date is required because non-initialed alterations allegedly have been made to the residence and post office address of Inventor Martin B. Leon. Applicants respectfully submit that efforts are currently underway to obtain the signature of Martin B. Leon on a Declaration for this application in which the current address is correct. Applicants will submit a new declaration in compliance with 37 C.F.R. 1.67(a) as soon as all necessary signatures have been obtained.

In re Application of:  
Kornowskiet al.  
Application No.: 10/776,545  
Filed: February 10, 2004  
Page 7

PATENT  
Attorney Docket No.: MEDIV2010-5

If the Examiner would like to discuss any of the issues raised in the Office Action, the Examiner is encouraged to call the undersigned so that a prompt disposition of this application can be achieved.

Please charge Deposit Account No. 07-1896 in the amount of \$65.00 for a Terminal Disclaimer fee. No additional fee is deemed necessary with the filing of this paper. However, the Commissioner is hereby authorized to charge any other fees that may be required by this paper or credit any overpayments to Deposit Account No. 07-1896, referencing the above-identified docket number.

Respectfully submitted,

Date: September 5, 2007



Lisa A. Haile, J.D., Ph.D.  
Registration No. 38,347  
Telephone: (858) 677-1456  
Facsimile: (858) 677-1465

DLA PIPER US LLP  
4365 Executive Drive, Suite 1100  
San Diego, California 92121-2133  
**USPTO Customer Number 28213**